

**Application No.:** 10/596,412  
**Filing Date:** June 13, 2006

### REMARKS

Claims 51-98 are now pending. Claims 1-50 have been canceled. Claims 53-99 are withdrawn. Claim 52 has been amended to clarify the claim language. Support for this amendment is found throughout the specification.

#### Unity of Invention

Applicants request reconsideration of the restriction requirement, based on unity of invention, of method Claims 53-73. The final product recited in Claim 52 substantially overlaps the final product recited in Claim 53 and the process step recited in both claims includes reacting the compound of Formula (V) to form the compound of Formula (I). The Office has not established how the processes materially differ. Thus, Applicants respectfully submit that unity exists as to these claims.

In addition, Applicants respectfully submit that unity of invention also exists between the method claims currently under examination (Claims 51 and 52), and the withdrawn product Claims 74-95 and method of use Claims 96-99.

According to MPEP § 1893.03(d):

Examiners are reminded that unity of invention (not restriction practice pursuant to 37 CFR 1.141 - 1.146) is applicable in international applications (both Chapter I and II) and in national stage applications submitted under 35 U.S.C. 371.

In addition, according to MPEP § 1850(I):

when the Office considers international applications ... during the national stage as a Designated or Elected Office under 35 U.S.C. 371, PCT Rule 13.1 and 13.2 will be followed when considering unity of invention of claims of different categories without regard to the practice in national applications filed under 35 U.S.C. 111.

MPEP § 1850(III)(A) further states:

The method for determining unity of invention under PCT Rule 13 shall be construed as permitting, in particular ... an independent claim for a given product, an independent claim for a process specially adapted for the manufacture of the said product, and an independent claim for a use of the said product....A process is specially adapted for the manufacture of a product if it inherently results in the product ....

**Application No.:** 10/596,412  
**Filing Date:** June 13, 2006

Moreover, the first example in the PCT INTERNATIONAL SEARCH AND PRELIMINARY EXAMINATION GUIDELINES, Chapter 10, paragraph 10.21 (available in the Patent Examiner's Toolkit link) states:

Claim 1: A method of manufacturing chemical substance X

Claim 2: Substance X

Claim 3: The (method of) use of substance X as an insecticide.

Unity exists between claims 1, 2 and 3. The special technical feature common to all the claims is substance X. However, if substance X is known in the art, unity would be lacking because there would not be a special technical feature common to all the claims.

Applicants respectfully submit that the claimed processes “inherently results” in the compounds recited in Claims 74-95.

MPEP § 1893.03(d) further states:

The sections of the MPEP relating to ... rejoinder of nonelected inventions (MPEP § 821.04) generally also apply to national stage applications submitted under 35 U.S.C. 371.

Thus, Applicants respectfully request rejoinder with respect to all of the claims in which unity exists, in accordance with US patent practice as outlined above.

MPEP § 1850 also states that:

the decision with respect to unity of invention rests with the International Searching Authority or the International Preliminary Examining Authority. However, the International Searching Authority or the International Preliminary Examining Authority should not raise objection of lack of unity of invention merely because the inventions claimed are classified in separate classification groups or merely for the purpose of restricting the international search to certain classification groups.

Applicants respectfully note that the International Searching Authority found no lack of unity of invention according to the Written Opinion dated March 24, 2005. Even if, for the sake of argument, unity did not exist at the time of the initial Restriction Requirement (when broader

**Application No.:** 10/596,412  
**Filing Date:** June 13, 2006

claims were pending) the claims have been amended during prosecution since then. It is respectfully submitted that all of the current claims have unity of invention.

**There are Clear Errors in the Rejection Under 35 U.S.C. § 103**

Applicants respectfully traverse the rejection of Claims 51-52 under 35 U.S.C. § 103 as obvious over Lee (US 6,689,779), Chen (US 7,129,259), Fukuda I (US 2005/0038092), II (US 2007/0185132) and Barbachyn I (US 5,523,403), II (US 5,565,571).

First, the Office has not considered the subject matter of Claims 51-52 “as a whole.” *See* Amendment filed May 11, 2009. Second, the Office has not established *prima facie* obviousness because the Office has not established that a) the claimed invention “as a whole” was obvious, and b) any of the cited references, alone or in combination, disclose or suggest the elements recited in Claims 51-52. Third, the Office has not applied the correct standard for determining obviousness.

To address the first issue, Applicants have made factual assertions regarding the material limitations of the method claims in their Response to Non-Final Office Action dated May 11, 2009 (page 17). The assertions of the material limitations in Claims 51-52 have not been rebutted or challenged by the Examiner. The failure of the Examiner to consider these assertions constitutes clear error. As the communications between the Applicants and the PTO establish the factual record, the unrebutted and unchallenged assertions regarding the material limitations of Claims 51-52 must be accepted as true factual findings (*see* M.P.E.P. § 707.07(f)).

Second, Applicants respectfully submit that a combination of three intermediate compounds that differ from three intermediate compounds of Formulae (III), (IV), and (VI) as recited in Claim 51, to arrive at different compounds than Formula (V) as recited in Claim 51 or Formula (I) in Claim 52 is insufficient to establish *prima facie* obviousness. The Office appears to agree in part by alleging that the “prior art process of Lee et al., Fukuda et al. II and Barbachyn et al. I, II, differ, at least, only in the starting material.” However, the cited references also differ in the final products produced by the process. Further, the Office referred to having motivation to “obtain[] the desired products” but has not established, at a minimum, why the products recited in the present claims are so desired without invoking impermissible hindsight.

Moreover, the Office alleges that Chen recites the instant alcohol of formula (II). Neither the present claims nor Chen recite an alcohol of Formula (II). Assuming for the sake of argument that the Office intended Formula (III) as in present Claim 51, the Office has not established that Chen discloses such a compound. For instance, in contrast to the Office's assertions, compound 92 in Chen (column 57, lines 35-45 and column 111-112) does not contain a "phenyl ring [that] is halogenated in the same position" presumably as in Formula III.

Therefore, as the Office has not established *prima facie* obviousness, the Examiner's rejection contains clear error.

Third, the Office concludes that the "reaction of a specific phenyl compound with a halogenating agent or tin reagent does not render the process step itself patentable (emphasis added)." As mentioned above, the Office has not considered the invention "as a whole." Therefore, the Office has not applied the correct standard for determining obviousness and, as a result, the rejection contains clear error.

As the Examiner has failed to examine the claimed invention as a whole, has not established that the cited references alone or in combination disclose or suggest all elements of the rejected claims, and has applied the incorrect standard for determining obviousness, this rejection contains clear error. The obviousness rejection is further deficient in light of the above un rebutted facts. As the factual findings of record strongly support non-obviousness of the claims over the cited references, the Examiner's failure to address and rebut Applicants' evidence and arguments constitutes clear error.

#### **Indefiniteness Rejection**

Applicants traverse the rejection of Claim 52 under 35 U.S.C. § 112, second paragraph, as being indefinite for use of the term "convert." Solely to clarify but not narrow the claim language, Applicants have amended Claim 52 to recite "react ... form" rather than "convert." In addition, according to MPEP § 2171 a claim is definite if "the scope of the claim is clear to a hypothetical person possessing the ordinary level of skill in the pertinent art." Applicants respectfully submit that one of ordinary skill in the art would understand the scope of the claims based on the teachings in the specification including the specific reacting steps outlined in the 58 Examples in the present specification. Withdrawal of this rejection is respectfully requested.

Application No.: 10/596,412  
Filing Date: June 13, 2006

### CONCLUSION

Applicants respectfully request rejoinder of the claims in accordance with the unity of invention standards. The indefiniteness rejection has been overcome and withdrawal is requested. The obviousness rejection of the claims is clearly erroneous and must be withdrawn.

#### No Disclaimers or Disavowals

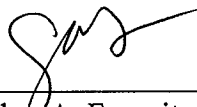
Although the present communication may include alterations to the application or claims, or characterizations of claim scope or referenced art, Applicants are not conceding in this application that previously pending claims are not patentable over the cited references. Rather, any alterations or characterizations are being made to facilitate expeditious prosecution of this application. Applicants reserve the right to pursue at a later date any previously pending or other broader or narrower claims that capture any subject matter supported by the present disclosure, including subject matter found to be specifically disclaimed herein or by any prior prosecution. Accordingly, reviewers of this or any parent, child or related prosecution history shall not reasonably infer that Applicants have made any disclaimers or disavowals of any subject matter supported by the present application.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: August 27, 2009

By:   
Carolyn A. Favorito  
Registration No. 39,183  
Attorney of Record  
Customer No. 20995  
(949) 760-0404

7671988:rms  
081909